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10/668,409	09/23/2003	Devon A. Rolf	300.10101	2042
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GOFIGURE, L.L.C. 26950 OLD KANSAS CITY ROAD PAOLA, KS 66071				
EXAMINER				
FIELDS, BENJAMIN S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,409

Applicant(s)

ROLF, DEVON A.

Examiner

BENJAMIN S. FIELDS

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 8 August 2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. The following is a **NON-FINAL** Office Action in response to the communication received on 8 August 2008. Claims 1-43 are now pending in this application.

Response to Amendments

2. The Examiner removes the originally asserted 35 U.S.C. 112 Rejection in view of the Applicants amendment.

3. Applicants Amendments to Claims 1-33 has been acknowledged in that: **NO Claims have been cancelled; Claims 2, 4, 8, and 32 have been amended; Claims 34-43 have been newly added;** hence, as such, **Claims 1-43 are pending in this application.**

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims **1-35** and **41-42** are rejected under 35 U.S.C. 101 because the claimed invention is not directed to a secondary statutory subject matter/class.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450

U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. In this particular case, Claims **1-35** and **41-42** are not tied to another statutory class, such as any hardware. Thus, it is unclear as to whether or not the claims are mere processes that involve purely human labor.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.: http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5-9 recite the limitation "... said communications service is ...". There is insufficient antecedent basis for this limitation in the claim (See the Claim/Claims to which Claims 5-9 depend upon for further guidance).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Early et al. (US PG Pub. No. 2003/0004868), [hereinafter Early] in view of Allen-Rouman et al. (US PG Pub. No. 2002/0152160), [hereinafter Allen-Rouman] further in view of Official Notice.

Referring to Claim 1: Early shows a method for electronically processing a commercial transaction, the method comprising: determining whether a monetary amount associated with the transaction meets a selected threshold amount (Early: Abstract); when said monetary amount associated with the transaction does not meet

said selected threshold amount, utilizing a first account for settling the transaction (Early: Abstract; Figures 1-4; Page 1, Paragraphs 0009-0010).

Early, however, does not expressly discuss when the monetary amount associated with the transaction does meet the selected threshold amount, utilizing a second account for settling the transaction.

Allen-Rouman, in a similar environment, teaches when the monetary amount associated with the transaction does meet the selected threshold amount, utilizing a second account for settling the transaction (Allen-Rouman: Abstract; Figures 1-4; Page 2, Paragraphs 0039-0041).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the system and method of Early for managing credit account products with adjustable credit limits with the feature of Allen-Rouman for an online funds transfer method and system for the purpose of diversifying transaction settlement means amongst the hundreds or thousands of financial transactions which occur on a daily basis (Allen-Rouman: Page 1, Paragraph 0013-Page 2, Paragraph 0040).

Referring to Claim 2: Early discusses a method, wherein said first account is an account of a user making the commercial transaction at a point of sale terminal, wherein said first account is associated with a communications service that is also available for use by the user for a communications service not related to the commercial transaction (Early: Page 2, Paragraphs 0023-0027//Early shows a method and system for managing accounts with adjustable credit limiting where communication services are

entailed – a communication device without any corresponding communication service is impossible//).

Early in combination with Allen-Rouman teach the method as set forth above.

Early in combination with Allen-Rouman, however, does not expressly show and wherein said first account is used to invoice the user for use of the communications service.

The Examiner takes Official Notice to the old and well known fact that customers/users of communication services as disclosed by the instant application have an associated invoicing established for the customer/user of the communications service.

Referring to Claim 3: Early teaches a method, wherein said second account is an account associated with a transaction processing service (Early: Page 1, Paragraph 19-Page 2, Paragraph 0027).

Referring to Claim 4: Early discloses a method, wherein said second account is selected from the group consisting of [a VISA account, a Master Card account, an American Express account, and a Discover account] a credit account (Early: Abstract; Page 1, Paragraph 0019-Page 3, Paragraph 0033//Early teaches a method and system for managing accounts with adjustable credit limiting where credit cards are used – any of such accounts could be from the group mentioned herein//).

Early, however, does not expressly teach a debit account.

Allen-Rouman, in a similar environment, discusses a debit account (Allen-Rouman: Page 1, Paragraph 0010-Page 2, Paragraph 0014).

Referring to Claims 5-9: Early shows the limitations of Claims 5-9.

Early, however, does not expressly discuss a method, wherein said communications service is a wireless communications service, a telecommunications service, a broad band communications service, a satellite communications service, and a cable communications service.

Allen-Rouman, in a similar environment, teaches a system and method wherein said communications service is a wireless communications service, a telecommunications service, a broad band communications service, a satellite communications service, and a cable communications service (Allen-Rouman: Figures 1-2; Page 3, Paragraphs 0045-0047).

Referring to Claim 10: Allen-Rouman discusses a method, wherein said first account is associated with a media service (Allen-Rouman: Figures 1-2; Page 3, Paragraphs 0045-0047; See Claims).

Referring to Claim 11: Claim 11 parallels the limitations of Claim 10. As such, Claim 11 is rejected under the same basis as is Claim 10 as mentioned supra.

Referring to Claims 12-14: Allen-Rouman discloses a method, wherein said communications device is a wireless communications device, an interactive television, and a telephone (Allen-Rouman: Figures 1-2; Page 3, Paragraphs 0045-0047).

Referring to Claim 15: Early in combination with Allen-Rouman teach the method as set forth above.

Early in combination with Allen-Rouman, however, does not expressly show wherein said telephone operates on an Internet protocol.

The Examiner takes Official Notice to the old and well known fact that telephones operate on the Internet protocol.

Referring to Claim 16: Allen-Rouman teaches a method, wherein said communications device is a personal computing device (Allen-Rouman: Figures 1-2; Page 3, Paragraphs 0045-0047).

Referring to Claim 17: Allen-Rouman discusses a method, wherein said transaction is guaranteed by a guarantor (Allen-Rouman: Page 9, Paragraph 0105-Page 10, Paragraph 0115).

Referring to Claim 18: Allen-Rouman shows a method, wherein said guarantor comprises at least one organization which provides communications or electronic media services (Allen-Rouman: Figures 1-2; Page 3, Paragraphs 0045-0047; Page 9, Paragraph 0105-Page 10, Paragraph 0115).

Referring to Claim 19: Allen-Rouman discloses a method, wherein said guarantor comprises a plurality of organizations which provide communications or media services (Allen-Rouman: Figures 1-2; Page 3, Paragraphs 0045-0047; Page 9, Paragraph 0105-Page 10, Paragraph 0115).

Referring to Claim 20: Allen-Rouman teaches a method, wherein said guarantor further comprises at least one organization which provides banking services (Allen-Rouman: Figures 1-2; Page 3, Paragraphs 0045-0047; Page 9, Paragraph 0105-Page 10, Paragraph 0115).

Referring to Claim 21: Allen-Rouman shows a method, wherein said guarantor comprises at least one organization which provides payment processing services (Allen-

Rouman: Figures 1-2; Page 3, Paragraphs 0045-0047; Page 9, Paragraph 0105-Page 10, Paragraph 0115).

Referring to Claim 22: Claim 22 parallels the limitations of Claim 1. As such, Claim 22 is rejected under the same basis as is Claim 1 as mentioned supra.

Referring to Claim 23: Claim 23 reflects the limitations of Claim 2. As such, Claim 23 is rejected under the same basis as is Claim 2 as mentioned supra.

Referring to Claim 24: Claim 24 parallels the limitations of Claim 10. As such, Claim 24 is rejected under the same basis as is Claim 10 as mentioned supra.

Referring to Claim 25: Claim 25 reflects the limitations of Claim 11. As such, Claim 25 is rejected under the same basis as is Claim 11 as mentioned supra.

Referring to Claim 26: Claim 26 parallels the limitations of Claim 17. As such, Claim 26 is rejected under the same basis as is Claim 17 as mentioned supra.

Referring to Claim 27: Allen-Rouman shows a method for electronically processing a commercial transaction, said method comprising: determining whether a merchant associated with said commercial transaction is an authorized merchant (Allen-Rouman: Page 3, Paragraphs 0045-0047; Page 8, Paragraph 0085-Page 10, Paragraph 0115); when it is determined whether said merchant associated with said commercial transaction is authorized, utilizing a first account for settling said commercial transaction (Allen-Rouman: Page 3, Paragraphs 0045-0047; Page 8, Paragraph 0085-Page 10, Paragraph 0115); and when it is determined that said merchant is not an authorized merchant, utilizing a second account for settling said

commercial transaction (Allen-Rouman: Page 3, Paragraphs 0045-0047; Page 8, Paragraph 0085-Page 10, Paragraph 0115).

Referring to Claim 28: Claim 28 parallels the limitations of Claim 2 and Claim 10. As such, Claim 28 is rejected under the same basis as are Claims 2 and 10 as mentioned supra.

Referring to Claim 29: Claim 29 reflects the limitations of Claim 3. As such, Claim 29 is rejected under the same basis as is Claim 3 as mentioned supra.

Referring to Claim 30: Claim 30 parallels the limitations of Claim 20. As such, Claim 30 is rejected under the same basis as is Claim 20 as mentioned supra.

Referring to Claim 31: Early in combination with Allen-Rouman disclose a method, wherein said first (Early: Abstract; Figures 1-4; Page 1, Paragraphs 0009-0010) and second accounts (Allen-Rouman: Abstract; Figures 1-4; Page 2, Paragraphs 0039-0041) are selectable by a user.

Referring to Claim 32: Allen-Rouman teaches a method, wherein a selection by a user of said first and second accounts is made on a user interface on a communications device associated with said communications or media service (Allen-Rouman: Page 3, Paragraph 0045-Page 5, Paragraph 0060).

Referring to Claim 33: The Examiner takes Official Notice to the old and well known fact that a method, or any method for the matter, wherein said selection results remain unchanged would result in a default setting to be in-tact.

Referring to Claim 34: Claim 34 reflects the limitations of Claim 4. As such, Claim 34 is rejected under the same basis as is Claim 4 as mentioned supra.

Referring to Claim 35: Early shows a method, wherein said first account comprises a credit account (Early: Abstract; Page 1, Paragraph 0019-Page 3, Paragraph 0033).

Referring to Claim 36: Claim 36 represents the system for the method of Claim 1. As such, Claim 36 is rejected under the same basis as is Claim 1 as mentioned supra.

Referring to Claims 37-38: Claims 37-38 parallel the limitations of Claim 1. As such, Claims 37-38 are rejected under the same basis as is Claim 1 as mentioned supra.

Referring to Claim 39: Claim 39 represents the system for the method of Claim 22. As such, Claim 39 is rejected under the same basis as is Claim 22 as mentioned supra.

Referring to Claim 40: Claim 40 represents the system for the method of Claim 27. As such, Claim 40 is rejected under the same basis as is Claim 27 as mentioned supra.

Referring to Claim 41: Early shows a method for processing a purchase transaction made by a customer at a point of sale terminal, said method comprising (Early: Page 2, Paragraphs 0023-0027): determining a monetary amount associated with said purchase transaction (Early: Abstract; Figures 1-4); when said monetary amount associated with said purchase transaction is within a first predetermined range, using a first payment account of the customer to settle said purchase transaction, wherein said first payment account further comprises an account that is used for

providing a communications, electronic content or media service to the user (Early: Abstract; Figures 1-4; Page 1, Paragraphs 0009-0010).

Early, however, does not expressly discuss and when said monetary amount associated with said purchase transaction is not within said first predetermined range, using a second payment account of the customer to settle said purchase transaction, wherein said second payment account comprises at least one of a debit account and a credit account that is associated with a financial service provider other than a provider of said communications, electronic content or media service.

Allen-Rouman, in a similar environment, teaches and when said monetary amount associated with said purchase transaction is not within said first predetermined range, using a second payment account of the customer to settle said purchase transaction, wherein said second payment account comprises at least one of a debit account and a credit account that is associated with a financial service provider other than a provider of said communications, electronic content or media service (Allen-Rouman: Abstract; Figures 1-4; Page 2, Paragraphs 0039-0041).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the system and method of Early for managing credit account products with adjustable credit limits with the feature of Allen-Rouman for an online funds transfer method and system for the purpose of diversifying transaction settlement means amongst the hundreds or thousands of financial transactions which occur on a daily basis (Allen-Rouman: Page 1, Paragraph 0013-Page 2, Paragraph 0040).

Referring to Claim 42: Claim 42 reflects the limitations of Claim 1. As such, Claim 42 is rejected under the same basis as is Claim 1 as mentioned supra.

Referring to Claim 43: Claim 43 represents the system for the method of Claim 42. As such, Claim 43 is rejected under the same basis as is Claim 42 as mentioned supra.

Response to Arguments

10. Applicants arguments filed 8 August 2008 have been fully considered but have been found to be **moot** and **non-persuasive** in view of the new grounds of rejection.

Examiner Note

11. **The Examiner has pointed out particular reference(s) contained in the prior art of record** within the body of this action for convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. **Applicant**, in preparing the response, should **fully consider the entire reference** as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

12. Any inquiry concerning this communication should be directed to BENJAMIN S. FIELDS at telephone number 571.272.9734. The examiner can normally be reached

MONDAY THRU FRI between the hours of 9AM and 7PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KAMBIZ ABDI can be reached at 571.272.6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin S. Fields
26 December 2008

/Harish T Dass/
Primary Examiner, Art Unit 3692